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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2622

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/234,559
Filing Date: January 20, 1999
Appellant(s): RAMAKESAVAN, SUNDARAM

MAILED

AUG 28 2006

Technology Center 2600

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/05/06 appealing from the Office action mailed 02/23/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2002-0336, decision mailed 09/10/03, and Appeal No. 2005-2401, decision mailed 08/31/05.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct, except for the mislabeling of stage 44, shown as a "display code" (page 7 of the Brief). The specification makes a single reference to this element spanning lines 15-16 on page 7, wherein it is described

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as an “acknowledgment number” block. This inconsistency was pointed to Appellant in the last Office action as an objection to the drawings, but was disregarded by Appellant in the Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant’s statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

I Claims 1-20, 23, 25 and 26 are now rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Appellant's amendment dated 06/26/00 in which language added to all six independent claims 1, 4, 10, 14, 16 and 17 covering the "automatic" requests, and the additional amendment to claims 10 and 14 (dated 08/03/00) is not covered by, nor can be derived from, the original disclosure. *Only* lines 11-22 on page 7 of the original specification addresses the pause/resume operation. *Nothing* in that text allows for any "automatic" operations. Subsequent to an initial pause request, an actual resumption is done by a *manual* prompting of a key, as expressly stated in the text on page 7, and the acknowledgement number (apparently the same as that sent with the pause authorization) is provided by the user with the resume request, which means that it too must be provided *manually*. *All* of the operations are therefore manually prompted by the user.

II Claims 1-20, 23, 25 and 26 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As pointed out above, all of the six independent claims recite " ...*automatically request(ing) a code to enable play to be resumed at a later time.*" It is not clear from the claim context, nor in light of the original disclosure, how the system can "automatically" request a code. In only one paragraph of the specification are the pause/resume operations discussed (lines 11-22 of page 7). The text therein does not describe any automatic requesting of any code, but only manual prompting. In fact, no mention of a code is even given.

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Corresponding Fig. 2 correlates “request code” 42 with a “pause authorization” which one of ordinary skill in the art would understand as being a signal *manually* initiated by the user in the requesting of a pause (thereby giving the user full control of this function, at his desire).

Step 44 in Fig. 2, shown labeled as a “display code,” is expressly designated as an “acknowledgement number” in the specification. The original disclosure does not give any explanation what the “number” represents beyond the implied role of providing the user with an indication that the provider has acknowledged the pause (why any acknowledgment would be necessary to inform the user who prompted the pause, and would presumably visibly notice the pause, is not understood; unless the number is used to acknowledge something else, but that is not specified). As explained above, the subsequent and actual resumption is done by a *manual* prompting of a key, as expressly stated in the text on page 7, and the acknowledgement number (apparently the same as that sent with the pause authorization) is provided by the user with the resume request, which means that it too must be provided *manually*.

In view of all of this, the claims as amended to include an “automatic” request is not clarified by the original disclosure, so relying therefore only on the claim language, the claims are accordingly misdescriptive and are indefinite in scope because how an “automatic” request is carried out is not understood nor explained as delimited by the claims.

The additional amendment to claim 10 (dated 08/03/00) in which an “acknowledgement code” is recited is also ambiguous if not misdescriptive because the specification only refers to an acknowledgment *number* which is implied therein as an acknowledgment of a pause. The user in turn sends a resume request and the acknowledgement number with the request to restart

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the play. The claim instead appears to require the acknowledgment “code” (rather than any actual resume prompt) to resume play.

Independent claim 14 also has additional misdescriptive claim language added in the amendment dated 08/03/00. The amended claim language therein is misdescriptive because the controller (provider) cannot “automatically” provide the “code” (i.e. the acknowledgement number, so implied by the specification), because it must react to a prompting by the user.

Because Appellant does not describe any actual “automatic” resumption of play based on any codes (so claimed in all six independent claims) and instead defines his invention by indefinite terms as explained above, then he has not provided any guidance to one of ordinary skill in the art how to make and use his claimed invention, though his original disclosure.

Pointing these errors out is not a minor matter, in view of the Board’s latest decision wherein it was decided that the difference between the prior art and applicant’s claimed invention hinges on “automatic” operations actually being used or not. In light of the fact that both the appellant argued that Dan likely uses manual requests, and the acknowledgment by the Board of that in fact, now allows the combination of Dan and Saward to be applied against applicant’s actual system described in his original disclosure. (Emphasis added by the examiner).

As an aside, the newly-cited reference to Dan (not applied in an art rejection) is related to Dan (of record), and expressly points out that the client requests including stop, resume and pause functions are processed by video player 230 which is embodied as program code and data structures instantiated in the memory of the video server (col. 3 lines 32-39).

(10) Response to Argument

Regarding the first argument dealing with new matter, it is emphasized that Appellant presents *only two sentences in his entire specification* covering the description of his block 44 (again, noting lines 14-18 on page 7).

It is also emphasized that Appellant presents *zero sentences in his entire specification* covering automatic requesting of a code involving resume of play (again, noting lines 14-22 on page 7 covering pause and resume, but devoid of any automatic requesting).

The user requests a pause by an upstream communication, and the provider (headend) provides an acknowledgement number of the pause (block 44). When the user wants to resume the play from the provider, he presses a resume key and provides the acknowledgement number. The provider provides the appropriate keys to the user to allow resumption of play. *This is the extent of the disclosure describing the pause/resume operation. Nothing involving automatic requesting of a code for play resumption is disclosed nor can be inferred therefrom.*

Appellant argues that the text in lines 14-22 on page 7 of the specification assumes the usage of software, which “necessarily” involves automatic operation.

Previously-applied Dan (noting the previous Board decision) also uses software, which then must also “necessarily” involve automatic operations. Just like appellant’s system, Dan also involves pausing by the user and play resumption by the user involving codes initiated by the user prompted by manual key selection. So does Appellant as explicitly described by the text on page 7.

Regarding the argument pertaining to the lack of enablement, *Appellant submits the exact argument that the examiner applied in the art rejection based on Dan in view of Saward* (noting

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lines 1-5 on page 12 of the Brief). The examiner pointed out that *after the user prompts the pause and resume keys*, the system then electronically responds by virtue of the information (of course as code data), flowing from the user to the provider and back, which *the Appellant* herein recognizes is an “automatic” process.

The Board instead discounted any “automatic” process because of the user initiates actions by key prompting. And here in his Brief the Appellant describes his system as operating in the same way. Since that is the case, according to that Board decision, then neither Dan nor Appellant use automatic requests. Therefore, the Appellant cannot claim doing such.

The Board is directed to review that rejection and its decision for reversal, which will show that (1) either Dan does in fact also involve automatic code transfer, or if he is not allowed to be interpreted as doing such, then (2) Appellant also cannot use automatic code requesting.

Furthermore, for Appellant to argue that the examiner is quibbling after six years of this “automatic” language not being challenged, is wrong. It has been raised in response to the Board decision (as noted in the **bold** text above in section 9 II). If the examiner were allowed to interpret the “automatic” request language as the Appellant apparently himself approves (noting again lines 1-5 on page 12 of the Brief), the issue would not have been raised. However, the Board unfortunately did not allow such, which compelled the examiner to show that the Appellant likewise is not entitled to such.

Appellant’s argument regarding a specific code that entitles a specific user to resume play is note relevant. Appellant’s claims do not require a user ID (the user’s station already has a unique address), and of course Appellant’s disclosure does not describe playback request as

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requiring a user ID code. The only code disclosed is the “acknowledgment number” which is not described in any more specific terms (looking once again at page 7 lines 14-22).

Therefore, in keeping with the directives governing patent examination, the examiner correctly raised this issue, and an accurate understanding and consistent assessment of the matter will show that the claims are indeed rejectable based on 35 USC 112 1st paragraph.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Victor R. Kostak



Conferees:

SPE David Ometz



DAVID OMETZ
SUPERVISORY PATENT EXAMINER

SPE Vivek Srivastava



VIVEK SRIVASTAVA
PRIMARY EXAMINER